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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,212	11/06/2003	Steve Davis	16222U-016100US	2931
66945 7590 10/04/2007 TOWNSEND AND TOWNSEND CREW LLP TWO EMBARCADERO CENTER, 8TH FLOOR SAN FRANCISCO, CA 94111			EXAMINER WORLOH, JALATEE	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 10/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/705,212

Applicant(s)

DAVIS, STEVE

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 25, 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-17, 19-26 and 28-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-17, 19-26 and 28-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 25, 2007 has been entered.

Response to Arguments

2. Applicant's arguments filed June 25, 2007 have been fully considered but they are not persuasive.

3. Applicant argues that "there is no motivation to modify *Sunder et al.* in the manner proposed by the Examiner, and obviousness has not been established with respect to claims 1, 10, 19, and any claims depending therefrom."

The Examiner notes that *KSR* forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See *KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396

4. As per claims 7, 16, and 25, Applicant argues that *Otto et al.* does not teach a pseudonym generated by a merchant system.

Applicant's argued that the *Otto et al.* fail to show a pseudonym generated by a merchant, it is noted that the features upon which Applicant relies (i.e. Applicant's arguments) are not recited in the rejected claim(s). That is, claims 7, 16, and 25 recites "wherein the authentication request includes a pseudonym corresponding to an electronic commerce card account number

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and previously created by the *central transaction* server.” Also, the rejection to claims 7, 16, and 25 indicates that Otto teaches this limitation not a merchant generating the pseudonym.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

5. Claims 1-8, 10-17, 19-26, and 28-37 have been examined.

Claim Objections

6. Claims 1-7 are objected to because of the following informalities: recites the intended use phrase “adapted to”. Note. “The recitation of a new intended use of an old product does not make a claim to that old product patentable”. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-2, 10-12 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Publication No. 2005/0021781 to Sunder et al. (“Sunder”) in view of U.S. Publication No. 2003/0046541 to Gerdes et al. (“Gerdes”).

Referring to claim 1, Sunder discloses receive an authentication request from a cardholder system (i.e. client device)(see paragraphs [0005] & [0007]), forward the authentication request to an access control server (see paragraph [0008]), relay authentication information between the access control server and the cardholder system receive an authentication response from the access control server and forward the authentication response to the cardholder system (see paragraphs [[0010] & [0011]). Sunder does not expressly disclose wherein the central transaction server is adapted to initiate a payment request process. Gerdes discloses a central transaction server is adapted to initiate a charge request via a card association network in response to receiving an authentication response from the access control server (see paragraph [0014]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder to include the central transaction server is adapted to initiate a charge request via a card association network in response to receiving an authentication response from the access control server. One of ordinary skill in the art would have been motivated to do this because it provides an additional level of security.

Referring to claim 2, Sunder discloses an electronic commerce card authentication system (see claim 1 above). Sunder does not expressly disclose the authentication response is adapted to be analyzed by a merchant system. Gerdes discloses the authentication response is adapted to be analyzed by a merchant system (see paragraph [0014] – the authentication server sends a confirmation of the user identity to the service provider. Based on the confirmation, the service provider finally grants service access to the user). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by

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Sunder to allow the merchant system to analyze the authentication response. One of ordinary skill in the art would have been motivated to do this because it provides authentication of a user to a service provider (see paragraph [0010] of Gerdes).

Referring to claim 3, Sunder discloses an electronic commerce card authentication system (see claim 1 above). Sunder does not expressly disclose wherein the central transaction server is adapted to forward a copy of the authentication response to an authentication history server to be archived. Gerdes discloses the central transaction server is adapted to forward a copy of the authentication response to an authentication history server to be archived (see paragraph [0057]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder to include a copy of the authentication response to an authentication history server. One of ordinary skill in the art would have been motivated to do this because it provides a history of authentication transaction (see paragraph [0057] of Gerdes).

Claims 10 and 19 are rejected on the same rationale as claim 1 above.

Claims 11 and 20 are rejected on the same rationale as claim 2 above.

Claims 12 and 21 are rejected on the same rationale as claim 3 above.

9. Claims 4-6, 13-15, 22-24, and 28 -31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunder and Gerdes as applied to claims 1, 10 and 14 above, and further in view of US Publication No. 2004/0254848 to Golan et al. ("Golan").

Referring to claims 4 and 5, Sunder discloses the electronic commerce card authentication system (see claim 1 above). Sunder does not expressly disclose wherein the central transaction server is further adapted receive a verifying enrollment request from a directory server, and to send a verifying enrollment response to the directory server; wherein the central transaction server is adapted to send the verifying enrollment response in response to a query to the access control server. Golan discloses wherein the central transaction server is further adapted receive a verifying enrollment request from a directory server, and to send a verifying enrollment response to the directory server; wherein the central transaction server is adapted to send the verifying enrollment response in response to a query to the access control server (see paragraphs [0094]-[0097] & claims 5,6). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder to include the system wherein the central transaction server is further adapted receive a verifying enrollment request from a directory server, and to send a verifying enrollment response to the directory server; wherein the central transaction server is adapted to send the verifying enrollment response in response to a query to the access control server. One of ordinary skill in the art would have been motivated to do this because provides an additional level of verification, thereby securing the system.

Referring to claim 6, Sunder discloses the electronic commerce card authentication system (see claim 1 above). Sunder does not expressly disclose the central transaction server is adapted to send the verifying enrollment response to the directory server with or without querying the access control server, and is further adapted to query the access control server in response to receiving an authentication request. Golan discloses the central transaction server is

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adapted to send the verifying enrollment response to the directory server with or without querying the access control server, and is further adapted to query the access control server in response to receiving an authentication request (see paragraphs [0099] & [0100]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclosed by Sunder to include the system wherein the central transaction server is adapted to send the verifying enrollment response to the directory server with or without querying the access control server, and is further adapted to query the access control server in response to receiving an authentication request. One of ordinary skill in the art would have been motivated to do this because it provides an additional level of verification, thereby securing the system.

Claims 13, 22, 28, and 30 are rejected on the same rationale as claim 4 above.

Claims 14 and 23 are rejected on the same rationale as claim 5 above.

Claims 15 and 24 are rejected on the same rationale as claims 6 above.

Referring to claims 29 and 31, Sunder discloses the electronic commerce card authentication system (see claims 28 and 30 respectively above). Sunder does not expressly disclose modifying the verifying enrollment request from a directory server, and forwarding the modified verifying enrollment response to the directory server. Golan discloses receiving a verifying enrollment request from a directory server, and to send a verifying enrollment response to the directory server and sending the verifying enrollment response in response to a query to the access control server (see paragraphs [0094]-[0097] & claims 5,6). Golan does not teach the request being modified; however, the concept of modifying data is well known in the art of data processing. Thus, at the time the invention was made, it would have been obvious to a person of

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ordinary skill in the art to modify the system disclose by Sunder to include the steps of disclose receiving a verifying enrollment request from a directory server, and to send a verifying enrollment response to the directory server and sending the verifying enrollment response in response to a query to the access control server. One of ordinary skill in the art would have been motivated to do this because provides an additional level of verification, thereby securing the system.

10. Claims 7, 16, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunder and Gerdes as applied to claims 1, 10 and 19 above, and further in view of US Publication No. 2001/0029496 to Otto et al. ("Otto")

Referring to claim 7, Sunder discloses the electronic commerce card authentication system (see claim 1 above). Sunder does not expressly disclose the authentication request includes a pseudonym corresponding to an electronic commerce card account number and previously created by the central transaction server. Otto discloses disclose the authentication request includes a pseudonym corresponding to an electronic commerce card account number and previously created by the central transaction server (see paragraph [0027] – [0029] –the user can submit the anonymous identifying information to the merchant; the merchant submits the request the banking network who then forwards the request to the financial institution that issued the anonymous card). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder to include a pseudonym corresponding the an electronic commerce card account number in the authentication request, the pseudonym previously created by the central transaction server. One of ordinary

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skill in the art would have been motivated to do this because it secures user's identity by providing a means for users to anonymously purchase goods and services over a network (see Otto paragraph [0007]).

Claims 16 and 25 are rejected on the same rationale as claim 7 above.

11. Claims 8, 17 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunder and Gerdes as applied to claims 1, 10 and 19 above, and further in view of US Publication No. 2003/0168510 to Allen.

Referring to claim 8, Sunder discloses the electronic commerce card authentication system (see claim 1 above). Sunder does not expressly disclose the authentication request includes a pseudonym previously created by a merchant system that corresponds to an electronic commerce card account number. Allen discloses a merchant generating a pseudonym (see abstract, paragraphs [0002] & [0028]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder to include a pseudonym previously created by the merchant. One of ordinary skill in the art would have been motivated to do this because it protects messages and information being transmitted during a transaction.

Claims 17 and 26 are rejected on the same rationale as claim 8 above.

12. Claims 34- 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over to Sunder et al. ("Sunder") and Golan in view of Allen.

Referring to claim 34, Sunder discloses receiving an authentication request from a holder system (i.e. client device)(see paragraphs [0005] & [0007]), sending the authentication request

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with the pseudonym to the access control server (see paragraph [0008]), receiving an authentication response and sending the authentication response to the holder system (see paragraphs [[0010] & [0011]). Sunder does not expressly disclose receiving a verifying enrollment request, sending the verifying enrollment response to an access control server, receiving a verifying enrollment response from the access control server, creating an altered verifying enrolling response comprising a pseudonym, sending the altered verifying enrollment response to a merchant system, wherein the merchant system subsequently sends an authentication request including the pseudonym to a holder system. Golan discloses receiving a verifying enrollment request, sending the verifying enrollment response to an access control server, receiving a verifying enrollment response from the access control server (see paragraphs [0094] – [0097] & claims 5, 6). As for creating an altered verifying enrollment response comprising a pseudonym and sending the altered verifying enrollment response to a merchant system, wherein the merchant system subsequently sends an authentication request including the pseudonym to a holder system, combining the pseudonym concepts taught by Sunder, the verification of enrollment concepts taught by Golan and the creation a pseudonym taught by Allen (see paragraphs [0002], [0028] & abstract) would result in these steps. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder to include the steps of receiving a verifying enrollment request, sending the verifying enrollment response to an access control server, receiving a verifying enrollment response from the access control server, creating an altered verifying enrolling response comprising a pseudonym, sending the altered verifying enrollment response to a merchant system, wherein the merchant system subsequently sends an authentication request

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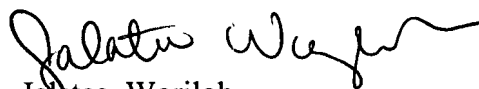
including the pseudonym to a holder system. One of ordinary skill in the art would have been motivated to do this because it provides an additional level of security.

As for claims 35-37, Sunder teaches these steps (see claim 34 above).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jalatee Worjloh
Primary Examiner
Art Unit 3621

September 10, 2007